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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,973	02/21/2002	Tetsu Shigetomi	450100-03762	2209

20999 7590 06/29/2006

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EXAMINER	
JONES, HEATHER RAE	
ART UNIT	**PAPER NUMBER**
2621	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/081,973	SHIGETOMI ET AL.	
	Examiner	Art Unit	
	Heather R. Jones	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The disclosure is objected to because of the following informalities:

a. Page 2, line 19: change "3" to –7--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 4, 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Dimitri et al. (U.S. Patent 6,574,424).

Regarding claim **1**, Dimitri et al. discloses an information reproducing apparatus comprising: a storing means (102) for storing a sequentially supplied series of broadcast information including commercial broadcast information linked with a supplied sequence; a commercial detecting means for detecting the commercial broadcast information from the broadcast information based on

predetermined identification information contained in the broadcast information (col. 4, lines 50-65 - it is inherent that there is a commercial detector in order to determine when and what commercial to playback); a reproducing means for reproducing broadcast information stored in the storing means (col. 4, lines 27-32); and a controlling means for sequentially reading the detected commercial broadcast information from the storing means and making the reproducing means reproduce the same and, when the detected commercial broadcast information is all reproduced, sequentially reading another series of broadcast information other than the related commercial broadcast information from the storing means and making the reproducing means reproduce it in accordance with the supplied sequence (abstract; col. 2, lines 17-26).

Regarding claim **3**, Dimitri et al. discloses all the limitations as previously discussed with respect to claim 1 including that the controlling means sequentially reads said detected commercial broadcast information from said storing means in accordance with a sequence by which said commercial broadcast information was supplied (col. 4, lines 56-65 – the commercials are played according to the instructions given along with them, for example only play certain commercials near meal time).

Regarding claim **4**, Dimitri et al. discloses all the limitations as previously discussed with respect to claim 1 including that the controlling means sequentially reads commercial broadcast information specified by an address of

a head part stored in the storing means and a data length identification information from designated in the storing means (col. 4, lines 10-16).

Regarding claims **17** and **19**, these are method claims corresponding to the apparatus claims 1 and 3. Therefore, claims 17 and 19 are analyzed and rejected as previously discussed with respect to claims 1 and 3.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitri et al. as applied to claims 1 and 17 above, and further in view of Barritz et al. (U.S. Patent Application Publication 2002/0019769).

Regarding claim **2**, Dimitri et al. discloses all the limitations as previously discussed with respect to claim 1, but fails to disclose that the controlling means generates a viewing confirmation message at least one time, makes the reproducing means reproduce it, and suspends a read operation of the broadcast information from the storing means at the time of reproduction of the commercial broadcast information and restarts the read operation of said broadcast information when a response signal with respect to the related viewing confirmation message is detected.

Referring to the Barritz et al., Barritz et al. discloses an information reproducing apparatus disclosing a viewing confirmation message at least one time, makes the reproducing means reproduce it, and suspends a read operation of the broadcast information from the storing means at the time of reproduction of the commercial broadcast information and restarts the read operation of said broadcast information when a response signal with respect to the related viewing confirmation message is detected (paragraph [0117]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the message system as disclosed by Barritz et al. with the information reproducing apparatus disclosed by Dimitri et al. in order to determine viewer presence during commercials.

Regarding claim **18**, this is a method claim corresponding to the apparatus claim 2. Therefore, claim 18 is analyzed and rejected as previously discussed with respect to claim 2.

7. Claims 5-7 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitri et al. as applied to claims 1 and 17 above.

Regarding claims **5**, **6**, and **7**, Dimitri et al. discloses all the limitations as previously discussed with respect to claim 1, but fails to disclose that the commercial detecting means detects the commercial broadcast information based on electronic watermark information included in image data of the broadcast information, or detecting scene changes where broadcast information changes discontinuously and detects the commercial broadcast information

based on a time interval at which said detected scene changes occur in the reproduced image, or detecting the commercial broadcast information based on fluctuations in the reproduced sound level of the broadcast information. Official Notice is taken that that there are several ways to detect commercial broadcast information, which include detecting the commercial broadcast information based on electronic watermark information included in image data of said broadcast information, or detecting scene changes where broadcast information changes discontinuously and detects the commercial broadcast information based on a time interval at which said detected scene changes occur in the reproduced image, or detecting the commercial broadcast information based on fluctuations in the reproduced sound level of the broadcast information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized any method of detecting commercial broadcasts in the information reproducing apparatus disclosed by Dimitri et al. in order to have a better quality commercial detector.

Regarding claims **20-22**, these are method claims corresponding to the apparatus claims 5-7. Therefore, claims 20-22 are analyzed and rejected as previously discussed with respect to claims 5-7.

8. Claims 8, 9, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitri et al. (U.S. Patent 6,574,424).

Regarding claim **8**, Dimitri et al. discloses an information reproducing apparatus comprising: a storing means (102) for storing a sequentially supplied

series of broadcast information including commercial broadcast information linked with a supplied sequence; a commercial detecting means for detecting the commercial broadcast information from the broadcast information based on predetermined identification information contained in the broadcast information (col. 4, lines 50-65 - it is inherent that there is a commercial detector in order to determine when and what commercial to playback); a reproducing means for reproducing broadcast information stored in the storing means (col. 4, lines 27-32); and a controlling means for sequentially reading the series of broadcast information from the storing means and making the reproducing means reproduce the same in accordance with the supplied sequence, generating image information corresponding to the detected commercial broadcast information and combining the same with the reproduced image of the series of broadcast information, and making the reproducing means reproduce it, and, when said commercial designation broadcast signal is input, reading the commercial information designated by the related commercial designation signal from said storing means and making the reproducing means reproduce it, and, in the following reproduction of the series of broadcast information, reproducing the broadcast information while not reproducing, but skipping over the commercial broadcast information which has been already reproduced (abstract; col. 2, lines 17-26. Although Dimitri et al. fails to explicitly state that in the following reproduction of the series of broadcast information, reproducing the broadcast information while not reproducing, but skipping over the commercial broadcast

information that has been already reproduced Official Notice is taken that the player would not keep replaying the same commercials because each sponsor paid to have their commercial in that time slot and therefore each commercial must be played in order to please each sponsor.

Regarding claim **9**, Dimitri et al. discloses all the limitations as previously discussed with respect to claim 8 including that the controlling means suspends reproduction of said series of broadcast information and makes the reproducing means reproduce designated commercial broadcast information when said commercial designation signal is input (col. 2, lines 18-27 – the commercials can be played during the movie).

Regarding claims **23** and **24**, these are method claims corresponding to the apparatus claims 8 and 9. Therefore, claims 23 and 24 are analyzed and rejected as previously discussed with respect to claims 8 and 9.

9. Claims 10-16 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitri et al. as applied to claim 8 above, and further in view of Kitsukawa et al. (U.S. Patent 6,282,713).

Regarding claim **10,** Dimitri et al. discloses all the limitations as previously discussed with respect to claim 8, but fails to disclose that the controlling means combines a still image of a reproduced image of the detected commercial broadcast information and a reproduced image of the series of broadcast information and makes the reproducing means reproduce the same.

Referring to the Kitsukawa et al. reference, Kitsukawa et al. discloses an information reproducing apparatus wherein the controlling means combines a still image of a reproduced image of the detected commercial broadcast information and a reproduced image of the series of broadcast information and makes the reproducing means reproduce the same (Fig. 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined a still image of a reproduced image of the detected commercial broadcast information and a reproduced image of the series of broadcast information as disclosed by Kitsukawa et al. with the information reproducing apparatus of Dimitri et al. in order to provide an on-demand electronic advertising information provided for items used in scenes of television programs.

Regarding claim **11**, Dimitri et al. in view of Kitsukawa et al. discloses all the limitations as previously discussed with respect to claims 8 and 10 including that the controlling means erases the still image of said commercial broadcast information from a display area of said reproducing means in the subsequent reproduction of the series of broadcast information when commercial broadcast information has been reproduced in accordance with said commercial designation signal (Kitsukawa et al.: Fig. 6).

Regarding claim **12**, Dimitri et al. in view of Kitsukawa et al. discloses all the limitations as previously discussed with respect to claims 8 and 10 including the controlling means changes the still image of the commercial broadcast

information to a predetermined image showing the commercial broadcast information finished being reproduced in the subsequent reproduction of the series of broadcast information when commercial broadcast information has been reproduced in accordance with the commercial designation signal (Kitsukawa et al.: Fig. 6 – after watching the commercial an indication to the user is given as to whether to store the commercial or to erase the commercial, therefore letting the user know that the commercial is finished).

Regarding claim **13**, grounds for rejecting claim 4 apply for claim 13 in its entirety.

Regarding claim **14-16**, grounds for rejecting claims 5-7 apply for claims 14-16 in their entirety.

Regarding claims **25-30**, these are method claims corresponding to the apparatus claims 10-12 and 14-16. Therefore, claims 25-30 are analyzed and rejected as previously discussed with respect to claims 10-12 and 14-16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones
Examiner
Art Unit 2621

HRJ
June 26, 2006